

REMARKS

Claims 1, 2, 4-10, and 12-21 were pending. Claims 1, 9, and 17 are amended. Support for the amendments to claims 1, 4, 5, 9, 12, 13 and 17 may be found in the specification and claims as originally filed. For example, support may be found in paragraphs [0026], [0031], [0040], and Figs. 1-4. No new matter is added. As a result, claims 1, 2, 4-10, and 12-20 are pending and at issue.

35 U.S.C. § 112 First Paragraph Rejections

The applicants respectfully traverse the 35 U.S.C. § 112, first paragraph rejections of claims 1, 2, 4-10, and 12-20. The amendments to claims 1 and 9 filed on June 20, 2007 were clearly described and fully supported by the specification and claims as originally filed. The file suspension devices are located within a storage area. Furthermore, the storage area is defined as being located between two wedge-shaped panels. Thus, the file suspension devices must be positioned between the two wedge-shaped panels. In support of this allegation, the specification as originally filed teaches that “[a] file suspension device 50 is provided within the storage area to suspend hanging file folders therein.” Emphasis added, *see* paragraph [0026]. Moreover, “wedge shaped panels 70 can extend rearwardly from the rear facing 46 of the openable panel 16 and be connected to and depend from the suspension surfaces 54. These panels can be provided and positioned to retain files and file materials within the storage area 40. These panels 70, if provided, define side or enclosure panels for the storage area 40 and confine the file folders 52 therebetween.” Emphasis added *see* paragraph [0031]. Because the file suspension device 50 is located between the panels 70, the entire file folder must also be located between the panels 70. Figs. 1 and 3 clearly teach this feature. In Fig. 3, the open configuration, no part of the file folder extends past the panel 70. Thus, the specification as originally filed fully supported the claim amendments filed on June 20, 2007. As a result, no new matter was added with the amendments filed on June 20, 2007. The applicants respectfully request withdrawal of the rejection of claims 1, 2, 4-10, and 12-16.

Similarly, the amendment to claim 17 filed on June 20, 2007 was clearly described and fully supported by the specification and claims as originally filed. The openable panel being pivotable between the open condition and the closed condition without moving the top

panel is shown in Figs. 1-4. Figs. 1 and 2 show a storage device in a closed or retracted condition. *See* paragraphs [0007]-[0008]. Figs. 3 and 4 show the storage device in an open condition. *See* paragraphs [0009]-[0010]. When comparing Fig. 1 (closed condition) with Fig. 3 (open condition), the top panel 24 is in the same position with respect to the side walls 18. In other words, the top panel 24 does not move when the openable panel 16 is opened. Thus, the specification fully supports the amendment to claim 17 filed June 20, 2007. The applicants respectfully request withdrawal of the rejection of claims 17-20.

The rejection of claims 1, 2, 4-10, and 12-20 should therefore be withdrawn in view of the amendments to claims 1, 2, 4-10, and 12-20 presented herein.

35 U.S.C. § 102 Rejections

The applicants respectfully traverse the rejection of claims 1-8 and 17-20 as allegedly anticipated by U.S. Patent No. 4,505,388 to Solomon (“Solomon”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987).

Claims 1-8

Each of claims 1-8 recites a file storage device having a file suspension device disposed adjacent to first and second panels, wherein a file disposed on the file suspension device is completely disposed between outer surfaces of the first and second panels. Emphasis added. Solomon fails to disclose or suggest such a file suspension device. To the contrary, Solomon discloses an expandable portable file having two side panels, a back panel, and a bottom, however, the upper edges of the two side panels form supports for the hanging files. *See* Solomon, abstract and Fig. 3. As a result, a portion of the hanging file is disposed outside of the storage space (i.e., not between the side panels). In other words, the hangar portion of the hanging file rests on top of, and hangs over, the side panels resulting in a portion of the file being disposed outside the storage space and not between the side panels.. *See* Solomon, Fig. 3. Thus, Solomon fails to disclose or suggest a file suspension device, wherein a file disposed on the file suspension device is completely disposed between outer surfaces of first and second panels. As a result, none of claims 1-8 are anticipated by Solomon and the applicants respectfully request withdrawal of the rejection of claims 1-8.

Claims 17-20

Each of claims 17-20 recites a file storage device having an exterior shell and a substantially horizontal top panel, wherein an openable panel is pivotable without opening a top panel. Solomon fails to disclose or suggest an openable panel that is pivotable without opening a top panel. To the contrary, as seen in Figs. 2 and 4 of Solomon, the top includes two projections that engage the front panel when the top is closed. Presumably, this structure facilitates holding “the file contents securely even when accidentally tipped or dropped,” which is an object of the Solomon disclosure. *See* Solomon, col. 1, lines 54-55. Therefore, the front panel is restricted from pivoting when the top is closed. In other words, a user must lift or open the top before the front panel may be moved. As a result, Solomon fails to disclose or suggest an openable panel that is pivotable without moving the top panel. The applicants respectfully request withdrawal of the rejection of claims 17-20.

35 U.S.C. § 103 Rejections

The applicants respectfully traverse the rejection of claims 9-16 as allegedly obvious over Solomon in view of U.S. Patent No. 4,666,047 to Fletcher. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. The cited art fails to disclose or suggest all claim limitations. In particular, each of claims 9-16 recites a file storage device having a file suspension device disposed adjacent to first and second panels, wherein a file disposed on the file suspension device is completely disposed between outer surfaces of first and second panels. As shown above, Solomon fails to disclose or suggest such a file suspension device.

Fletcher also fails to disclose or suggest such a file suspension device, nor was Fletcher cited as disclosing such an element. Fletcher is cited solely to show “a series of notches.” *See* the official action, page 5. Regardless, Fletcher fails to show a file suspension device of any sort. Rather, Fletcher discloses rails and hangars that “facilitate examination of the sheets and drawings which are suspended from the hangers.” Emphasis added, *see* Fletcher, col. 4, lines 8-11. Thus, Fletcher fails to cure the deficiency of Solomon and for this reason, the rejection of claims 9-16 should be withdrawn.

Conclusion

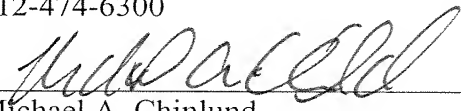
In view of the above amendments, the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned.

Enclosed is a Request for Continued Examination and the required fee. No other fees are believed due. However, the director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29618/39225.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
312-474-6300

By:


Michael A. Chinlund
Registration No. 55,064
Agent for Applicants

October 30, 2007